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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,362	11/28/2000	Teresa F. Lunt	104136	4303

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EXAMINER	
SINGH, SATWANT K	
ART UNIT	**PAPER NUMBER**
2626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/722,362	Applicant(s) LUNT ET AL.	
	Examiner Satwant K. Singh	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *3-5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification is objected to because of the following informalities: Brief Description of the Drawings is missing a description of Fig. 9.

Appropriate correction is required.

2. The specification is objected to because of the following informalities: Typographical errors on the following pages.

Page 5, lines 23 and 29 – change 40 to 140

Page 10, line 17 – change "31 or 33" to "131 or 133"

Appropriate correction is required.

Preliminary Amendment

3. The preliminary amendment is objected to because of the following informalities: Page 2 of the amendment refers to page 15, lines 7, 16, and 33 of the specification. This could not be located on the referenced page. The amendment was not entered by the examiner.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al (US 6,233,684).

Regarding claim 1, Stefik et al disclose a method processing an image of a document including at least one page (reads on trusted printer) (col.3, lines 11-14); determining a forgery protection to be applied to the document (reads on dynamically generated watermark information that is embedded) (Abstract, line 6); and based on the determined protection level, printing at least one watermark including copy evidence and tracing information on each page of the document that corresponds to the determined protection level (reads on watermark data typically provides information relating to the owner of the digital work .... Preventing unauthorized copying of the rendered work) (Abstract, lines 7-13).

6. Regarding claim 2, Stefik et al disclose a method wherein the copy evidence is encoded in the watermark (reads on watermarks are designed to make copies distinguishable from the originals) (col. 5, lines 15-16).

7. Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al (US 6,233,684).

Regarding claim 14, Stefik teaches a document forgery protection printing system comprising at least one image processor that processes an image of document including at least one page (reads on trusted printer) (col.3, lines 11-14); at least one server having a print management system and a policy that determines a forgery protection level of the document (reads on rendering system) (col. 7, lines 11-13, 21-25); a plurality of printers, each printer able to print the document and able to apply at

least one protection level to the document by printing at least one watermark including copy evidence and tracing information on the document that corresponds to the determined protection level (reads on server based trusted printers) (col. 16 lines 58-65).

8. Regarding claim 15, Stefik et al disclose a method wherein the copy evidence is encoded in the watermark (reads on watermarks are designed to make copies distinguishable from the originals) (col. 5, lines 15-16).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al in view of Livingston (US 6,621,590).

Regarding claim 3, Stefik teaches a method of embedding a document with dynamically generated watermark information which provides information relating to the owner as well as preventing unauthorized copying of the work (Abstract, lines 6-13). Stefik fails to teach that the watermarks may vary with each page of the document.

Livingston teaches a method where other watermarks have been applied to other pages of the document. Therefore, it would have been obvious to one of ordinary skill

in the art at the time of the invention to have modified Stefik by the teaching of Livingston to put different watermarks on different pages of the document.

11. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik and Livingston as applied to claim 3 above, and further in view of Cyr et al (US 6,138,913).

Regarding claim 4, Stefik et al teach a method of embedding a document with dynamically generated watermark. Livingston teaches a method where different watermarks have been applied to different pages of the document. Stefik and Livingston fail to disclose the chemical composition of the watermarks as well as the location of the watermark.

Cyr et al teach a method wherein the watermark is imprinted on the substrate using an ink or other appropriate marking composition containing a fluorescing compound sensitive to radiation (col. 4, lines 43-46). Additionally, Cyr teaches that encoded information can be positioned anywhere (col. 5, lines 12-17). Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to have modified Stefik and Livingston by using the marking composition taught by Cyr for imprinting the watermarks.

12. Regarding claim 5, Stefik et al teach a method of embedding a document with dynamically generated watermark using data technology such as glyph technology. Livingston teaches a method where different watermarks have been applied to different pages of the document. Stefik and Livingston fail to disclose the chemical composition of the watermarks as well as the location of the watermark.

Cyr et al teach a method wherein the watermark is imprinted on the substrate using an ink or other appropriate marking composition containing a fluorescing compound sensitive to radiation (col. 4, lines 43-46). Additionally, Cyr teaches that encoded information can be positioned anywhere (col. 5, lines 12-17). Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to have modified Stefik by using the marking composition taught by Cyr for imprinting the watermarks.

13. Claims 6, 8-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al in view of Cyr et al (US 6,138,913).

Regarding claims 6, Stefik et al teach a method of embedding a document with dynamically generated watermark information which provides information relating to the owner as well as preventing unauthorized copying of the work (Abstract, lines 6-13). Stefik fails to disclose the chemical composition of the watermarks

Cyr et al teach a method wherein the watermark is imprinted on the substrate using an ink or other appropriate marking composition containing a fluorescing compound sensitive to radiation (col. 4, lines 43-46). Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to have modified Stefik by using the marking composition taught by Cyr for imprinting the watermarks.

14. Regarding claim 9, Stefik et al teach that tracing information is encoded in the watermark (reads on the watermark data typically provides information relating to the owner of the digital work) (Abstract, lines 7-13). Stefik et al fail to teach the chemical composition of the watermark. Therefore, it would have obvious to one of ordinary skill

in the art at the time of the invention to have modified Stefik by using the marking composition taught by Cyr for imprinting the watermarks.

15. Regarding claims 8, 10-11, and 13 as best understood by the language of the claims are rejected for the same reasons as claim 6.

16. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al in view of Cyr et al (US 6,138,913).

Regarding claim 7, Stefik et al teach that the watermarks are created with embedded data technology such as glyph technology (col. 10, lines 20-23). Stefik et al fail to teach the chemical composition of the watermark. Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to have modified Stefik by using the marking composition taught by Cyr for imprinting the watermarks using glyph technology.

17. Regarding claim 12, as best understood by the language of the claims are rejected for the same reasons as claim 7.

18. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al in view of Livingston (US 6,621,590).

Regarding claim 16, Stefik teaches a method of embedding a document with dynamically generated watermark information which provides information relating to the owner as well as preventing unauthorized copying of the work (Abstract, lines 6-13). Stefik fails to teach that the watermarks may vary with each page of the document.

Livingston teaches a method where other watermarks have been applied to other pages of the document. Therefore, it would have been obvious to one of ordinary skill

in the art at the time of the invention to have modified Stefik by the teaching of Livingston to put different watermarks on different pages of the document.

19. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik and Livingston as applied to claim 3 above, and further in view of Cyr et al (US 6,138,913).

Regarding claim 17, Stefik et al teach a method of embedding a document with dynamically generated watermark. Livingston teaches a method where different watermarks have been applied to different pages of the document. Stefik and Livingston fail to disclose the chemical composition of the watermarks as well as the location of the watermark.

Cyr et al teach a method wherein the watermark is imprinted on the substrate using an ink or other appropriate marking composition containing a fluorescing compound sensitive to radiation (col. 4, lines 43-46). Additionally, Cyr teaches that encoded information can be positioned anywhere (col. 5, lines 12-17). Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to have modified Stefik and Livingston by using the marking composition taught by Cyr for imprinting the watermarks.

20. Regarding claim 18, Stefik et al teach a method of embedding a document with dynamically generated watermark using data technology such as glyph technology. Livingston teaches a method where different watermarks have been applied to different pages of the document. Stefik and Livingston fail to disclose the chemical composition of the watermarks as well as the location of the watermark.

Cyr et al teach a method wherein the watermark is imprinted on the substrate using an ink or other appropriate marking composition containing a fluorescing compound sensitive to radiation (col. 4, lines 43-46). Additionally, Cyr teaches that encoded information can be positioned anywhere (col. 5, lines 12-17). Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to have modified Stefik by using the marking composition taught by Cyr for imprinting the watermarks.

21. Claims 19, 21-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al in view of Cyr et al (US 6,138,913).

Regarding claims 19, Stefik et al teach a method of embedding a document with dynamically generated watermark information which provides information relating to the owner as well as preventing unauthorized copying of the work (Abstract, lines 6-13). Stefik fails to disclose the chemical composition of the watermarks

Cyr et al teach a method wherein the watermark is imprinted on the substrate using an ink or other appropriate marking composition containing a fluorescing compound sensitive to radiation (col. 4, lines 43-46). Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to have modified Stefik by using the marking composition taught by Cyr for imprinting the watermarks.

22. Regarding claim 22, Stefik et al teach that tracing information is encoded in the watermark (reads on the watermark data typically provides information relating to the owner of the digital work) (Abstract, lines 7-13). Stefik et al fail to teach the chemical composition of the watermark. Therefore, it would have obvious to one of ordinary skill

in the art at the time of the invention to have modified Stefik by using the marking composition taught by Cyr for imprinting the watermarks.

23. Regarding claims 21, 23-24, and 26 as best understood by the language of the claims are rejected for the same reasons as claim 6.

24. Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al in view of Cyr et al (US 6,138,913).

Regarding claim 20 Stefik et al teach that the watermarks are created with embedded data technology such as glyph technology (col. 10, lines 20-23). Stefik et al fail to teach the chemical composition of the watermark. Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to have modified Stefik by using the marking composition taught by Cyr for imprinting the watermarks using glyph technology.

25. Regarding claim 25, as best understood by the language of the claims are rejected for the same reasons as claim 20.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703) 306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Satwant K. Singh
Examiner
Art Unit 2626

sks

MARK WALLERSON
PRIMARY EXAMINER